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10/587,779	07/28/2006	Gordon Thelwell	5897-0000029/US/NP	9918
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HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			RODDEN, JOSHUA E	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,779	<b>Applicant(s)</b> THELWELL, GORDON
	<b>Examiner</b> Joshua Rodden	<b>Art Unit</b> 4136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 28 July 2006.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 61-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 61-88 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 July 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date 07/28/2006
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Specification***

1. The disclosure is objected to because of the following informalities:  
(Page 3, Line 28), "organisation's" should be "organizations"  
Appropriate correction is required.

***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 81-86 have been renumbered 82-87.

***Claim Rejections - 35 USC § 102***

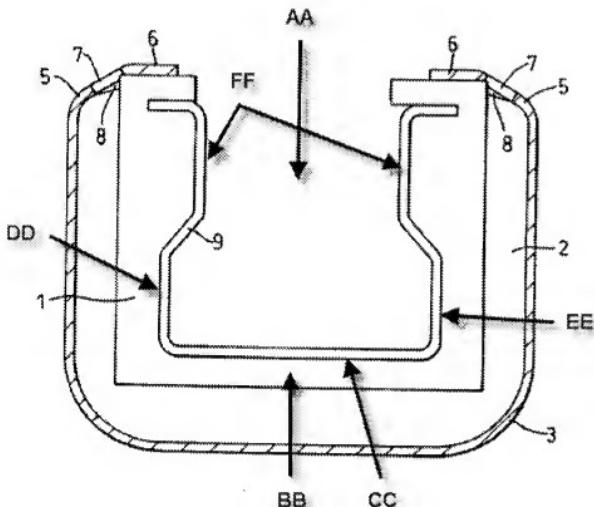
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claim 61-64, 71-73, 80-83, and 86-88 are rejected under 35 U.S.C. 102(b) as being anticipated by U.K. Patent Application GB 2,321,688 A (ian).**

Regarding **Claim 61**, Ian teaches; a column protecting device (3) for protection of an upright column (9) of a racking system, (Figure 3); wherein the column (9) has a channel shaped cross section (AA) having a substantially rectangular front portion (BB) consisting of a front member (CC), and a first (DD) and second (EE) side member, (Annotated Figure 2 Below); the protector device further comprises a substantially rigid outer shell (3), and an inner liner (1) shaped to fit within the outer shell (3), (Figure 2); wherein the outer shell (3) is capable of fitting around the upright column so that the outer shell (3) retains to the column (9) without further fixtures, (Page 4, Lines 10-14); the outer shell (3) also surrounds the front member (CC) and partially surrounds the first (DD) and second (EE) side members, (Annotated Figure 2); the inner liner (1) being retained between the outer shell (3) and the column (9), (Figure 3).



Annotated Figure 2

The phrase, "thereby protecting the front and parts of the side members" is considered functional language and is given no patentable weight.

Regarding **Claim 62**, Ian teaches each first and second side member comprising an outer side member (DD and EE) and an inner side member (FF), (Annotated Figure 2 Above); wherein the outer shell (3) surrounds the front member (CC) and the first (DD) and second (EE) side members, and further surrounds the first and second inner side members (FF) so that the peripheral edge of the outer shell is adjacent to the column where the column is relatively narrower, (Annotated Figure 2).

The term "peripheral" is defined by [www.dictionary.com](http://www.dictionary.com) as "Related to, located in, or constituting an outer boundary or periphery." Furthermore, the phrase "thereby protecting them" is considered functional language and is given no patentable weight.

Regarding **Claim 63**, Ian teaches the device (3) capable of attaching to the front or lateral sides of an aisle facing an upright column wherein the column resides in a channel of the outer shell (2 or 3), (Figure 3 and Page 1, Lines 5-11).

Regarding **Claim 64**, Ian teaches the outer shell (3) having a "C" shaped cross section, (Figure 2).

Regarding **Claim 71**, Ian teaches the outer shell being made from polycarbonate, (Page 2, Line 8).

Regarding **Claim 72**, Ian teaches the inner liner being a part-cylindrical member, (Figure 1(b)).

Regarding **Claim 73**, Ian teaches a substantially solid part cylindrical outer surface (2) having a substantially U-shaped channel formed on the opposite side of the outer surface (2), (Figure 1(b)).

Regarding **Claim 80**, Ian teaches the inner lines returning to their original shape after being deformed, (Page 4, Lines 3-8).

Regarding **Claim 81**, Ian teaches the outer shell (3) surrounding the front member (CC) and partially surrounding the first (DD) and second (EE) side members, and also surrounding the inner liner (1), which rests between a substantially part cylindrical inner surface of the outer shell (3) and an outer face of the front member

(CC), an outer face of the first side member (DD) and second side members (EE),  
(Annotated Figure 2 Above).

The phrase, "thereby protecting the front member and parts of the side members from direct impact and partially surrounds each of the first and second side members," is considered intended use and is given no patentable weight.

Regarding **Claim 82 (Misnumbered 81)**, Ian teaches the inner liner and outer shell being slideable with respect to each other along a central axis of the outer shell, (Page 1, Lines 24-28).

Regarding **Claim 83 (Misnumbered 82)**, Ian teaches an outer liner and an inner liner being bonded together, (Page 2, Lines 1-5). Additionally, Ian teaches the inner liner and outer shell being bonded together using plastic cable ties, (Page 4, Lines 16-20).

Regarding **Claim 86 (Misnumbered 85)**, Ian teaches the outer shell and the inner liner composed of polycarbonate and foam, (Page 2, Line 8 and Page 2, Lines 6-7); both materials having greater ductility, and impact resilience than the shelving which is made from metal (Page 1, Lines 12-14).

Regarding **Claim 87 (Misnumbered 86)**, Ian teaches the device being capable of fitting around the upright column so that the outer shell (3) retains to the column (9) without further fixtures, (Page 4, Lines 10-15).

Regarding **Claim 88**, Ian teaches; a column protecting device (3) for protection of an upright column (9) of a racking system, (Figure 3); a substantially part cylindrical rigid outer shell (3), (Figure 2); an inner liner (1 and 2) shaped to fit within the outer shell (3), (Figure 2); wherein the outer shell (3) is capable of fitting around the upright column so

that the outer shell (3) retains to the column (9) without further fixtures, (Page 4, Lines 10-14); and the inner liner (1) being retained between the outer shell (3) and the column (9), (Figure 3).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

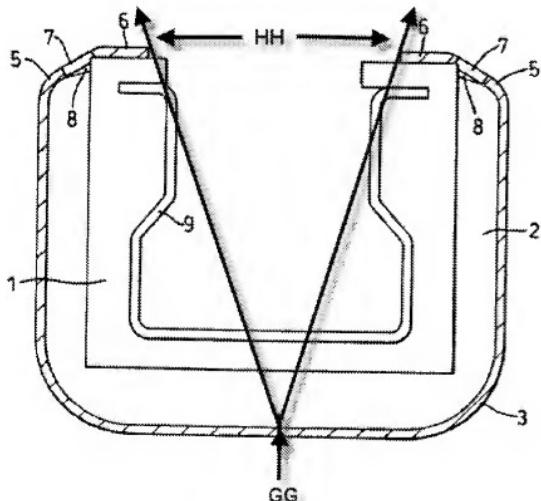
6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 65-69, 74, and 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (Ian).**

Regarding **Claim 65**, Ian teaches the outer shell (3) comprising a tubular part cylindrical member (3), (Figure 3); wherein the tube has a pair of substantially parallel opposing edges (6) on either side of a gap, (Figure 2). Ian does not teach the cylindrical member extending over an angle in the range of 260 to 280 degrees, but does teach a range (HH) about a longitudinal centre line (GG) of the outer shell (3) which is very

similar to the claimed range, (Annotated Figure 2 Below). Therefore, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144).



Annotated Figure 2

Regarding **Claims 66-69**, Ian teaches the limitations discussed above but does not teach the dimensional aspects of the claimed invention. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777

(Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the column protector of **Ian** with a height between 30-120cm, an external diameter of 10-14cm and an outer wall thickness between 7-9mm since the column protector of **Ian** would operate equally as well with any desired dimensions. In further regards to **Claim 69**, **Ian** teaches a pair of opposing edges (6), (Figure 2).

Regarding **Claim 74**, **Ian** teaches the inner liner (Figure 1(b)) having a U-shaped channel formed but does not teach the exact dimensions. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the column protector of **Ian** with a distance between the outer part cylindrical surface and the outer surface of the U-shaped channel between 2-5cm since the column protector of **Ian** would operate equally as well with any desired dimensions.

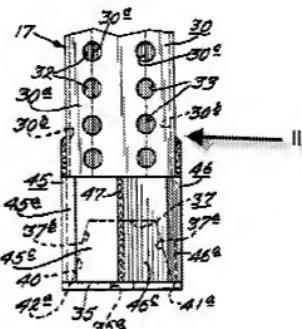
Regarding **Claims 76-79**, Ian teaches the limitations discussed above but does not teach the dimensional aspects of the claimed invention. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). In further regards to **Claims 78 and 79**, Ian teaches the inner liner (2 or 1) being U-shaped, (Figures 1(a) and 1(b)). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the column protector of Ian with a height between 30-120cm, an external diameter of 10-14cm and an outer wall thickness between 7-9mm since the column protector of Ian would operate equally as well with any desired dimensions.

8. **Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (Ian) in view of U.S. Patent No. 4,088,229 (Jacoby et al.).**

Regarding **Claim 70**, Ian teaches the limitations discussed above, but does not teach the outer shell having a chamfered edge. However, **Jacoby et al.** teaches a shell of a protector having a chamfered edge (II) between its outer and inner surface, (Annotated Figure 4 Below). Therefore, it would have been obvious to one of ordinary

Jacoby et al. for the purpose of user efficiency and improved protection.

FIG. 4.



#### Annotated Figure 4

9. Claim 75 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (Ian) in view of U.S. Patent Application Publication No. 2001/0047975 (Lazas et al.).

Regarding **Claim 75**, **Ian** teaches the limitations as discussed above, but does not teach the inner liner being composed of one of the claimed materials. However, **Lazas et al.** teaches the use of polypropylene material in a post protector. Therefore, it would have been obvious to one of ordinary skill in the art to modify **Ian** to have an inner liner composed of polypropylene material as taught by **Lazas et al.** for the purpose of improving the effectiveness of the device and cheaper to manufacture.

**10. Claim 84 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.K.**

**Patent Application GB 2,321,688 A (Ian) in view of U.S. Patent No. Re 32,406 E (Molari, Jr.)**

Regarding **Claim 84 (Misnumbered 83)**, Ian teaches the limitations as discussed above, but does not teach an polycarbonate outer sheath on the outer shell. However, Molari, Jr. teaches of layers of polycarbonate for impact protection, (Column 1, Lines 18-29). Therefore, it would have been obvious to one of ordinary skill in the art to modify Ian to have an additional polycarbonate sheath as taught by Molari, Jr. for the purpose of added protection. Furthermore, it is an inherent property of carbonate to crack under a given amount of force.

**11. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.K.**

**Patent Application GB 2,321,688 A (Ian) in view of U.S. Patent No. 5,746,622 (Consoli et al.).**

Regarding **Claim 85 (Misnumbered 84)**, Ian teaches the limitations as discussed above, but does not teach a polycarbonate insert. However, Consoli et al. teaches a polycarbonate insert (150) capable of being inserted between the device and the front face of a column, which is capable of being removed and re-inserted for visual inspection without removing the outer or inner liners, (Figure 3 and Column 4, Lines 1-15). Therefore, it would have been obvious to one of ordinary skill in the art to modify Ian to have a polycarbonate insert as taught by Consoli et al. for the purpose of efficiently testing the device.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patents No. 2,166,798 (Cote), No. 4,113,110 (Mittag), No. 7,090,428 (Hinojosa), and No. 7,104,514 (Ciarlo) all disclose similar style post protectors.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patent Examiner whose telephone number is (571) 270-5222. The examiner can normally be reached on M-Th 8am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Allen Shriver can be reached on (571) 272-6698. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua Rodden/  
Examiner, Art Unit 4136  
/Jerry Redman/  
Primary Examiner, Art Unit 3634